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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|--------------------------|------------------|
| 10/677,120 | 10/01/2003 | David C. Lowery | I201.158.102 (10354US02) | 3904 |
| 7590 | 07/06/2006 | | EXAMINER | |
| David C. Lowery P.O. Box 64898 St. Paul, MN 55164-0898 | | | | RICKMAN, HOLLY C |
| | | ART UNIT | | PAPER NUMBER |
| | | 1773 | | |

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/677,120 | LOWERY ET AL. | |
| | Examiner | Art Unit | |
| | Holly Rickman | 1773 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 24 March 2006.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-10 and 16-22 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-10, 16-22 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10 and 16-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mori et al. (US 5510168).

Mori et al. disclose a magnetic recording tape having a non-magnetic substrate and upper and lower magnetic layers thereon. The layers contain iron particles and an abrasive material such as alumina (corresponding to the claimed “head cleaning agent”) dispersed in a binder. The reference discloses an example wherein the amount of alumina (head cleaning agent) is present in an amount of 10 pbw based on 100 pbw of magnetic metal powder. See col. 5, lines 27-32 see col. 11, lines 1-20.

The reference does not disclose the claimed abrasivity index of the recording medium. The examiner takes the position that the structure taught by Mori et al. inherently satisfies the claim limitations directed to abrasivity index by virtue of the fact that the reference discloses a

structure that is substantially the same as claimed (i.e., magnetic metal particles containing Fe dispersed in a binder with an alumina head cleaning agent).

It has been held that where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess characteristics of claimed products where the rejection is based on inherency under 35 USC §102 or on prima facie obviousness under 35 USC §103, jointly or alternatively. *In re Best, Bolton, and Shaw*, 195 USPQ 430. (CCPA 1977).

In the alternative, the examiner takes the position that it would have been obvious to one of ordinary skill in the art to determine the optimal value of the abrasivity index of the magnetic layer taught by Mori et al. Such an optimization would have been obvious in view of Mori's teaching of adding abrasive materials to the recording medium. In the absence of evidence of any criticality associated with the claimed Abrasivity Index values, the examiner maintains that determining the optimal value of this parameter would have been a matter of routine experimentation.

With regard to the limitations of claims 8-9, it is the examiner's position that the recitations of a DLT tape are recitations of intended use. The recording medium taught by the prior art are substantially the same as claimed are therefore, would be expected to be capable of functioning in the claimed capacity. These limitations do not add any structural features to the magnetic recording medium defined in claim 1 and therefore, do not patentably distinguish over the prior art.

Claims 21-22 include process limitations in article claims. These limitations do not present any patentable distinction over the applied prior art. It has been held that even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Response to Arguments

4. Applicant's arguments filed 3/24/06 have been fully considered but they are not persuasive.

Applicant argues that Mori does not inherently teach the claimed abrasivity index. Applicant maintains that even if the exact materials are utilized in Mori, the resultant tape may have an abrasivity index that is different than claimed as a result of the method of manufacture used. The examiner maintains that the claimed product and the prior art product disclosed by Mori are substantially identical for the reasons of record. As such, the burden is shifted to Applicant's to establish that Mori does not necessarily or inherently meet the claim limitation directed to abrasivity index. As noted above, it has been held that where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess characteristics of claimed products where the rejection is

based on inherency under 35 USC §102 or on prima facie obviousness under 35 USC §103, jointly or alternatively. *In re Best, Bolton, and Shaw*, 195 USPQ 430. (CCPA 1977).

Applicant's reference Example 1 and Comparative Example 1 as evidence that the same structure subjected to different burnishing conditions exhibit different abrasivity indices. However, the example and comparative example are not commensurate in scope with the claimed invention. Claim 1 is not limited to a structure that is limited to the specific materials or manufactured by the specific methods described in the example. Thus, this evidence is not persuasive.

Applicant further argues that it would not have been obvious to optimize the abrasivity index of the structure taught by Mori because Mori doesn't describe why abrasivity is important or provide any guidance as to how to optimize. However, Applicant does note that the specification provides some information about what is conventional in the art with regard to optimization of abrasivity. Applicant's arguments on this subject suggest to the examiner that the claimed abrasivity index is either unexpectedly low or results in some unexpected properties not previously recognized in the art. However, no evidence has been set forth to rebut what the examiner maintains is a prima facie case of obviousness. Thus, the 103 rejection of the claims in view of Mori has been maintained in the absence of evidence of unexpected results commensurate in scope with the claimed invention.

With regard to the examiner's position that the recitations of a DLT tape are recitations of intended use, Applicant argues that the limitation "a DLT tape" imparts "particular technical characteristics" to the claimed magnetic recording medium. It is not clear to the examiner from the specification or the prior art what these characteristics are and how they patentably

distinguish the claimed invention over the applied prior art. Applicant is asked to specifically point out what these technical characteristics are if it is believed that they relate to a structural or material feature of the tape that distinguishes over the prior art.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Rickman whose telephone number is (571) 272-1514. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Holly Rickman
Primary Examiner
Art Unit 1773